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September 26, 2005

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR APPEAL BRIEF

RE: Applicant(s):	Jürgen Pingel et al.		
Assignee:	Sun Microsystems, Inc.		
Title:	A METHOD AND SYSTEM FOR CREATING A REFERENCE DATABASE FOR A COMPUTER-READABLE DOCUMENT		
Serial No.:	09/728,783	Filed:	November 30, 2000
Examiner:	Leslie Wong	Group Art Unit:	2167
Docket No.:	P-4582		

Dear Sir:

Transmitted herewith are the following documents for the Notice of Appeal filed on July 26, 2005 in the above application:

1. Return receipt postcard;
2. Check in the amount of $500.00 for fee set forth in §41.20(b)(2) for filing of Appeal Brief;
3. This Transmittal Letter (2 pages); and
4. Appeal Brief (29 pages).

☒ Conditional Petition for Extension of Time: If an extension of time is required for timely filing of the enclosed documents after all papers filed with this transmittal have been considered, Applicant(s) hereby petition for such an extension of time.

Transmittal Letter
Serial No. 09/728,783
September 26, 2005

☒ The Commissioner is hereby authorized to charge any additional fees required for consideration of the enclosed documents, and to credit any overpayment of fees to Deposit Account No. 50-0553.

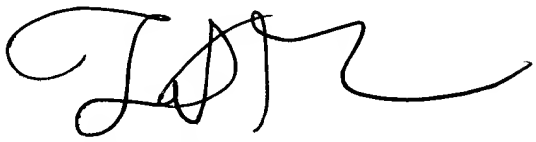
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 26, 2005.

Attorney for Applicant(s) of Signature

September 26, 2005
Date

Respectfully submitted,



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Jürgen Pingel et al.		
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APPELLANT'S BRIEF

Dear Sir:

Pursuant to 37 CFR § 41.37(a)(1), Appellant files this Appellant's Brief in support of the Notice of Appeal entered by the USPTO on July 26, 2005.

REAL PARTY IN INTEREST

The assignee of the above-referenced patent application, Sun Microsystems, Inc., is the real party in interest.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to the undersigned Attorney for Appellant, or the Assignee Appellant, which will directly affect, or be directly affected by, or have a bearing on the Board's decision in this pending Appeal.

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STATUS OF CLAIMS

Claims 1 to 24 are pending. Claims 1 to 24 stand rejected in the Final Office Action of March 23, 2005. The rejections of Claims 1 to 24 are hereby appealed.

STATUS OF AMENDMENTS

In response to the final office action, Appellant filed a paper dated June 21, 2005 requesting reconsideration. An Advisory Action was issued on July 7, 2005, but the entry status of the June 21, 2005 paper was not given in the advisory action.

SUMMARY OF CLAIMED SUBJECT MATTER

With respect to Claims 1 to 24, embodiments in accordance with the present invention provide

> . . . a method 100 for creating a reference database for a computer-readable document (Figs. 1A and 2) where, the reference database is included with the computer-readable document in a single document file 250 [Figs. 2 & 6]. The computer-readable document contains at least text data and at least one reference to reference data that is included in the reference database . . .

Specification, Page 5, lines 26 to 33.

> Since the document file contains the text data and the reference data in a single file, the user can always edit the text data as well as the reference data, and only one document needs to be transferred to another storage medium or remote device.

Specification, Page 2, line 34 to Page 3, line 3.

A summary is provided below for each independent claim and for each dependent claim argued separately.

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CLAIMS 1, 10, 15, and 22

With respect to Claims 1 and 15, user inputted text data (Specification 6, line 5; operation S1, Fig. 1A) for a computer readable document is entered in a data file 250 (Figs. 2 and 6). ("[A] single data file,[is] sometimes called a document file" Specification, Page 2, lines 32, 33.) Input reference data check operation S2 [Fig. 1A] determines whether the user wants to stop inputting text data and instead input reference data. As shown, for example in Figs. 4 and 5, the reference data characterizes a reference data source. If the user input a request to enter reference data, the inputted reference data (See Figs. 4 and 5) is entered (S3 to S5 in Fig. 1A) in the reference database 602 (Fig. 6). The reference database 602, text data 601 and other data are stored (S6 in Fig. 1A) in a single data file 250. The other data includes at least one citation (Specification, page 7, lines 8 to 11.)

At least Fig. 2 in combination with the above description shows the apparatus of Claim 10. See also, Specification, Page 9, line 33 to page 10, line 12.

At least the description at Page 7 lines 26 Page 8, line 9 in combination with the above description shows the computer program product of Claim 22.

CLAIMS 7, 21, and 24

Claim 7 includes the limitations of Claim 1 as described above. Claim 21 includes the limitations of Claim 15, as described above, and the limitations of Claim 20 that includes displaying a user interactive dialogue window on a display screen (See Fig. 5, for example). Claim 24 includes the limitations of Claim 22, as described above, and the limitations of Claim 23, where the other data is shown in at least Fig. 6. In addition, each of Claims 7, 21, and 24 includes synchronizing the reference database with other data

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sources that is described for example at page 3, lines 16 to 18, and page 4, lines 23 to 26.

CLAIM 9

Claim 9 includes: the limitations of Claim 1, as described above; the limitations of Claim 8 wherein said method (100) is stored as computer code in a storage medium (211), (211A), (211C); and the computer code is downloaded into the storage medium (See for example, Fig. 3B and the description at Specification, page 10, line 34 to page 11, line 7.

CLAIM 11

Claim 11 includes the limitations of Claim 10 and the configuration shown for example in Fig. 3A where for example the processor is processor 212A and the storage medium is memory 211B storing document file 250.

CLAIMS 5 and 19

Claim 5 includes the limitations of Claim 1, as described above; the limitations of Claim 3 that includes fields for different types of reference data sources (401 to 405) and fields containing specific information that are illustrated for example in Fig. 4; the limitations of Claim 4 wherein the reference database comprises a bibliographic database (See for example, page 3, lines 4 to lines 12); and one field (405) containing information about a number of citations of a reference in the document.

Claim 19 includes the limitations of Claim 15, as described above; the limitations of Claim 17 that includes fields for different types of reference data sources (401 to 405) and fields containing specific information that are illustrated for example in Fig. 4; the limitations of Claim 18 wherein the reference database comprises a bibliographic

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database (See for example, page 3, lines 4 to lines 12); and one field (405) containing information about a number of citations of a reference in the document.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claims 1 to 4, 6, 8, 10, 12 to 18, 20, and 22 to 23 are patentable over U.S. Patent No. 5,097,418 of Nurse et al., hereinafter referred to as "Nurse", in view of U.S. Patent No. 5,867,678 of Amro et al., herein after referred to as Amro?

2. Whether Claims 7, 9, 11, 21, and 24 are patentable over U.S. Patent No. 5,097,418 of Nurse et al., hereinafter referred to as "Nurse", in view of U.S. Patent No. 5,867,678 of Amro et al., herein after referred to as Amro, and further in view of U.S. Patent No. 6,529,911 of Mielenhausen, hereinafter referred to as Mielenhausen?

3. Whether Claims 5 and 19 are patentable over U.S. Patent No. 5,097,418 of Nurse et al., hereinafter referred to as "Nurse", in view of U.S. Patent No. 5,867,678 of Amro et al., herein after referred to as Amro, and further in view of U.S. Patent No. 6,289,342 of Lawrence et al., hereinafter referred to as Lawrence?

ARGUMENT

1. Claims 1 to 4, 6, 8, 10, 12 to 18, 20, and 22 to 23 are patentable over U.S. Patent No. 5,097,418 of Nurse et al. in view of U.S. Patent No. 5,867,678 of Amro et al.

Requirements for a Prima Facie Obviousness Rejection

To make a prima facie obviousness rejection, the MPEP directs:

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BASIC CONSIDERATIONS WHICH APPLY TO OBVIOUSNESS REJECTIONS

When applying 35 U.S.C. 103, the following tenets of patent law mmust be adhered to:

(A) The claimed invention must be considered as a whole;

(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

(D) Reasonable expectation of success is the standard with which obviousness is determined.

MPEP § 2141, 8th Ed., Rev. 2, p. 2100-120 (May 2004). It is noted that this directive stated "the following tenets . . . **must be adhered to**." Accordingly, the failure of the Examiner to adhere to any one of these tenets means that a prima facie obviousness rejection has not been made.

The final rejection failed to adhere to multiple of these tenets and so a prima facie obviousness rejection has not made. As demonstrated more completely below, the claimed invention has not been considered as a whole; the references have not been considered as a whole; and the references do not suggest the desirability of making the combination. Pieces of the references have been extracted and selectively interpreted in view of Appellant's claims. Finally, there was no explanation of how the primary reference would work for its intended purpose following the modification.

Neither Nurse nor Claim 1 was considered "as a whole"

In the rejection of Claim 1, the Examiner first stated in part (all emphasis in original):

> a). **'entering user inputted text data for said computer-readable document in a data file'** as the present invention allows an ordinary word processing applications document to be extensively edited, including substantial resequencing of text, without the need to review all

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> footnote/endnote insertions for the use of the correct form (col. 2, lines 18-23; col. 1, lines 41-51);

Final Office Action dated 03/23/2005, page 3.

Col. 2, lines 18 to 23 of Nurse, which were paraphrased in this part of the rejection, stated:

> Also, for ordinary word processing applications, the present invention has the advantage of allowing a document to be extensively edited, including substantial resequencing of text, without the need to review all footnote/endnote insertions for the use of the correct form.

This portion of Nurse teaches nothing concerning how the information was stored and provided information only concerning one advantage of the invention of Nurse with respect to eliminating the need to review footnotes after resequencing of text.

In considering the claim invention as a whole, "a data file" must be interpreted as used in the whole claim. Claim 1 recites:

> storing the reference database, . . . text data and other data . . . in said data file.

Thus, the data file includes three elements: the reference database, text data, and other data. Considering "data file" in isolation ignores these claim limitations.

The advisory action stated "Applicant's claimed limitation . . . does not require the Office to show where the various items are stored." This explicit statement demonstrates that both the claim limitation and "data file" were considered in isolation. The claim was dissected into pieces and the pieces rejected. This alone is sufficient to demonstrate that an improper form of analysis has been done and a prima facie obviousness rejection has not been established.

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Nurse Teahes How Information and Citations Are Stored

Considering Nurse as a whole includes determining whether Nurse teaches how information and citations are stored. With respect to how information and citations are stored, Nurse repeatedly teaches (See Paper dated June 21, 2005, bottom of page 2 to the middle of page 4):

> . . . The CPU 31 accesses addressed memory 34 which contains . . . instructions for manipulation of that information in accordance with the operating sequences of the present invention. These sequences are directed toward developing a specific database 5 of information and linked source citation information under command of the processor 6 . . . (Emphasis added).

Nurse, Col. 3, lines 31 to 39.

> Information is entered with an Editing Process 4, which encodes the information into a suitable format and places it into a storage area of Database 5, including the recording of the source of that information. (Emphasis added.)

Nurse, Col. 3, lines 50 to 54.

> Once the information and source citations have been entered into the database 5, the user proceeds to invoke one or more of several format processes 6, which have been designated Formats A, B, and C in the diagram. (Emphasis added.)

Nurse, Col. 4, lines 4 to 8.

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> Once information and linked source citations have been entered into the database 5, reports 37 can be printed. As the printed report 37 is prepared by either format process A, B, or C, an element 48 is added to an array 47 in database 5 each time information is taken from database 5 that contains a citation to one of the designated sources 1, 2, or 3. (Emphasis added.)

Nurse, Col. 4, lines 54 to 60.

These quotations from Nurse make several points clear. Each point must be considered in the evaluation of Nurse, as a whole. Nurse distinguishes between information and source citations. Both the information and the source citations are described as being stored in a database.

Thus, Nurse explicitly teaches that everything is stored in a database, and not as separate entities in a single data file, as recited in Claim 1. The information is not described by Nurse as being stored as a separate entity in a data file, but rather the information is encoded into a suitable format and placed in the database. The only storage for data and linked source documentation shown in the drawings of Nurse is database 5 of Nurse. Thus, Nurse unambiguously shows and describes that a database is used to store both the information and the source citations.

The Final Rejection and The Advisory Action Mischaracterize Nurse

This teaching of Nurse with respect to storing the entities in a database was taken directly from the reference. Nevertheless, the advisory action stated ". . . the reference has to explicitly suggest or disclose the so-called teach away steps--Applicants assertion cannot be accepted if it is unsupported by valid evidence." Quotations from a reference are valid evidence, and this evidence must be considered in the "as a whole" evaluation of the reference. The statement in the

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advisory action is further evidence that the MPEP requirements have not been met.

This statement in the advisory action follows on a similar statement in the final rejection. In particular, the final rejection stated:

> **Nurse** does not explicitly teach storing the reference database, said user inputted text data, and other data of the computer-readable document in said data file. (Emphasis in original).

Final Office Action dated 03/23/2005, page 4, d).

It is correct that Nurse does not teach that three discrete items are stored in a data file, but to the extent that the rejection infers that Nurse fails to explicitly teach storing both information and linked source citations, the rejection is incorrect. In fact, as quoted above, Nurse explicitly teaches storing all the various elements in a database. Specifically, Nurse teaches that the elements were stored in the database 5 (Nurse, Fig. 1), which teaches away from storage in a data file as three discrete elements as recited in Claim 1. The characterization of Nurse in this portion of the rejection as failing to explicitly teach where the various items are stored demonstrates that Nurse was not considered as a whole and in fact, mischaracterizes Nurse. (See Paper Filed on June 21, 2005, First and Second Full Paragraphs on Page 4).

Hindsight Was Used In Interpreting The Secondary Reference, Amro

The final rejection continued:

> **Amro**, however, teaches '**storing the reference database, said user inputted text data, and other data of the computer-readable document is said data file**' as a compound document contains multiple objects capable of

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> running within the document, such as a spreadsheet (i.e., database), text, and hotlinks etc. . . (col. 4, lines 4-7 and Fig. 1). (Emphasis in original.)

Final Office Action dated 03/23/2005, page 4, d).

This portion of the rejection mischaracterizes the cited teaching of Amro. This portion of the rejection also fails to cite any teaching of how the compound document is stored. Amro, Col. 4, lines 4 to 7 stated:

> A compound document 11 contains multiple objects capable of running within the document, such as a spreadsheet, text, hotlink, picture, sound, and video objects.

The portion of Amro, relied upon in the rejection, is nothing more than a definition of a compound document. Such a definition fails to teach anything about how the elements that make up the compound document are stored.

Nurse, as quoted above, stores all the elements in a database. The cited section of Amro provides only a definition of a compound document. Thus, the only basis in the rejection, as quoted above, for determining how the elements are stored is Appellant's bolded claim language and not the cited teachings in the prior art. Thus, not only has Nurse not been considered as a whole, but also this portion of the rejection is clear evidence of "impermissible hindsight."

The MPEP directs:

> Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and **the legal conclusion must be reached on the basis of the facts gleaned from the prior art.** (Emphasis added)

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MPEP §2142, 8th Ed., Rev. 2, pg. 2100-128 (May 2004).

Appellant demonstrated above that the facts gleaned from the prior art do not support the legal conclusion reached. This is additional independent evidence that the obviousness rejection is not well founded.

The Claim Language Was Reduced To A "Gist"

Moreover, assuming that the characterization of Amro was correct, the rejection would still be defective. The rejection based on Amro, as quoted above, characterizes a spreadsheet as a database. The explicit language of Claim 1 ("a reference database" where "the reference data base" includes "user inputted reference data" where "said reference data characterizes a reference data source") has been reduced to a gist--"spreadsheet (i.e., database)"--in the rejection. The claim language does not recite a generic database, but rather limits the database to a reference database having particular characteristics. This is yet additional evidence that the claim language has not been considered "as a whole."

In particular,

DISTILLING THE INVENTION DOWN TO A "GIST" OR "THRUST" OF AN INVENTION DISREGARDS "AS A WHOLE" REQUIREMENT

> Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole."

MPEP § 2141.02, 8th Ed., Rev. 2, p. 2100-125 (May 2004).

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The Motivation For The Combination Of References Is Not Well Founded Because Multiple Requirements of the MPEP Were Not Followed

At this point in the rejection, Nurse teaches that the elements are stored in a database, and a definition of a compound document has been cited. There has been no motivation given for modifying Nurse to include a compound document, or any teaching of why Nurse would store such a document in other than the database taught by Nurse. The motivation in the final rejection was:

> It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Amro's** teaching would have allowed **Nurse's** to ensure that all reference related data is available for access by binding separate documents together can create a well organized, coherent collection of information as suggested by Kanerva at col. 1, lines 15-18.

Final Office Action dated 03/23/2005, page 4, d).

This motivation falls short of complying with the MPEP's requirements. First, the rejection is not proper. For example, the rejection was based only on "Nurse et al.... in view of Amro et al." Final Office Action dated 3/23/2005, paragraph 3., page 2. Accordingly, the final rejection does not identify the reference used to provide the motivation by other than "Kanerva." In response to the final office action and in this appeal, Appellant has assumed the Kanerva refers to U.S. Patent No. 6,507,858. If this is the correct reference it is further evidence that the "as a whole" requirement in considering the prior art was not met.

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The Rejection Failed to Consider Kanerva as a Whole

Kanerva, at Col. 1, lines 15 to 18 taught:

> Binding **separate paper documents** together can create a well organized, coherent collection of information. The separate documents become sections of the bound collection. Binding sections together is the reason **traditional three-ring paper binders were created.** (Emphasis added.)

Thus, the rejection relies on a teaching of placing separate **paper** documents in a three ring binder as a motivation for modifying Nurse. The cited section of Kanerva addresses multiple documents and not how entities in a single document are handled. The motivation also ignores the fact that the very next paragraph of Kanerva shows that when the model of a three ring binder is followed for computer documents, the binding of the documents does not result in a single file. Specifically,

> In the electronic documents environment, there are several methods of "binding" electronic document files or sections together. First, document files can be organized or "bound" together in a directory. However, **the document files are stored separately, not as a single file**, making it more cumbersome to copy or to electronically mail the documents files. Additionally, the files within the directory cannot be maintained in a user-definable order **nor can the directory itself be transferred** (e.g., copied or electronically mailed) **as a single file**. (Emphasis Added)

Indeed, the rejection asserted that one of skill in the art would ignore the very next and following paragraphs in Kanerva and would use a description of binding paper documents as a basis for modifying Nurse and Amro. However, this is incorrect because Kanerva demonstrates that results obtained from binding paper documents do not apply directly to electronic documents.

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Nurse Taught the Rationale for the Motivation But Arrived at A Different Result

The stated rationale for the motivation was that the combination of references "would have allowed **Nurse's** to ensure that all reference related data is available." As demonstrated in the above quotations from Nurse, this is exactly what Nurse did with database 5 (Fig. 1 of Nurse.) More specifically, Nurse provided a way to "create a well organized, coherent collection of information," and in fact Nurse taught, as quoted above,

> the present invention has the advantage of allowing a document to be extensively edited, including substantial resequencing of text, without the need to review all footnote/endnote insertions for the use of the correct form (Emphasis Added.)

Nurse, Col. 1, lines 41 to 51.

Further,

> . . . the present invention automates the citing of information sources by freeing the operator from the need to remember when a source has already been cited and, if it has been referred to more than once, what standard short form text to use. . .(Emphasis added.)

Nurse, Col. 2, Lines 24 to 28. These citations show that Nurse provided the functionality used as the rationale for the motivation without any alterations. Accordingly, one of skill in the art using the Examiner's logic would have no reason to look beyond Nurse and would use the database solution of Nurse without modification.

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The Rationale For The Motivation Failed To Establish That Nurse, After Modification, Would Work

Finally, the motivation failed to explain how the spreadsheet in the compound document of Amro would be used to implement the database of Nurse. Nurse, as quoted above, stored all the elements in a database. The rejection failed to cite any suggestion or teaching in Nurse of storing the information and source citations in other than a database. The rejection has failed to cite any teaching or suggestion in either reference for storing the information in the particular way cited in the rejection and relies solely upon quoting Appellant's claim language.

As quoted above, the rejection characterized a spreadsheet in Amro as a database. However, the rejection has failed to establish how the multiple different items stored in database 5 by Nurse would be changed to store some in a spreadsheet and to store others in some undefined way and still allow all the data to be manipulated as required by Nurse, which relies upon the database structure. (The rejection does not explain what portions of Nurse would be broken out and stored as separate entities and does not provide any rationale for why one would make such a selection other than Appellant's claim language.)

The MPEP requires that after the proposed modification that the invention of Nurse still works for its intended purpose. (See MPEP § 2143.01 "**THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE.**") A conclusory statement comparing a spreadsheet to a database reduces the complex method of Nurse to a gist and fails to consider how the various flow diagrams of Nurse would be implemented using a spreadsheet and data stored in some other way than in the spreadsheet. There has been no showing that after reducing the database application of Nurse to a spreadsheet and separating data from the spreadsheet to meet the limitations in Appellant's claims that Nurse would work for its intended purpose.

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Nurse, as quoted above, used only the database for storing information and citations. Moving information out of the database and storing it in a different way would mean that Nurse would no longer work, because a query to the database for the moved information would generate an error.

The Motivation Failed to Consider Evidence in the References

The rationale for the motivation is also evidence that requirements of the MPEP have not been met. Specifically,

> **PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS**
>
> A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.

MPEP § 2143.02, 8th Ed., Rev. 2, p. 2100-127, (May 2004).

As noted above, Nurse taught that a database was used and the cited section of Amro failed to show how or in what the compound document was stored. The rejection requires a rearrangement of the teaching of Nurse, i.e., storing elements in other than a database, and assumptions about how one of skill in the art would store a compound document, which have not been supported by citation to any prior art reference. Putting paper documents in a three ring binder, as cited in Kanerva, provides no insight on how to make the modifications and rearrangement required.

This rearrangement of the teaching of Nurse and the unsupported assumptions go against the explicit sequence of operations defined by Nurse, as quoted above, and is further evidence as originally stated that neither the references nor Appellant's claim were considered as a whole. Again, the MPEP directs:

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> **FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS**
> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

MPEP § 2143.01, 8th Ed., Rev. 2, p. 2100-131, (May 2004).

As noted above, the binding of paper documents in Kanerva fails to provide any rationale or teaching on how to modify Nurse to include the compound document of Amro and still have Nurse work for its intended purpose. Therefore, Kanerva fails to suggest the desirability of the combination.

The evidence is simply overwhelming that the references were not considered as a whole and instead pieces were extracted from the references based upon Appellant's claim language. As noted originally, only one of the numerous errors noted above is necessary to overcome the obviousness rejection.

In conclusion, Appellant has explained why the combination of Nurse et al. in view of Amro et al., taken as a whole, does not suggest the subject matter of Claim 1. Thus, the Examiner's rejection of Claim 1 as being unpatentable over the combination of Nurse et al. and Amro et al. should be reversed.

Each of independent Claims 10, 15, and 22, each of Claims 2 to 4, 6 and 8 that depend from Claim 1, each of Claims 12 to 14 that depend from claim 10, each of Claims 16 to 18 and 20 that depend from Claim 15, and Claim 23 that depends from Claim 22 include, or depend from, a claim that includes limitations similar to those discussed above for Claim 1 and that discussion is incorporated herein by reference. Therefore, each of Claims 2 to 4, 6, 8, 10, 12 to 18, 20, and 22 to 23 distinguish over the combination of references for at least the same reasons as Claim 1.

In conclusion, Appellant has explained why the combination of Nurse et al. in view of Amro et al., taken as a whole, does not suggest the subject matter of Claims 1, 2 to 4, 6, 8, 10,

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12 to 18, 20, and 22 to 23. Thus, the Examiner's rejection of Claims 1, 2 to 4, 6, 8, 10, 12 to 18, 20, and 22 to 23 as being unpatentable over the combination of Nurse et al. and Amro et al. should be reversed.

2. Claims 7, 9, 11, 21 and 24 are patentable over Nurse and Amro in combination with Mielenhausen.

Claims 7, 9, 11, 21, and 24 stand rejected as obvious in view of Nurse and Amro taken together with U.S. Patent No 6,529,911, hereinafter referred to as Mielenhausen.

Claims 7, 21 and 24 Are Patentable Over The Combination of References

Assuming that the combination of the three references is correct and that the interpretation of the three references is correct (Appellant notes that by making these assumptions Appellant does not concede that either of these facts is correct), the additional information from the third reference does not correct the deficiencies of the two primary references as noted above with respect to Claim 1 and incorporated herein by reference.

Information in the third reference has been taken out of context and interpreted incorrectly. Nowhere, in the cited portions of Mielenhausen, is synchronization mentioned, let alone the specific type of synchronization recited in Claims 7, 21 and 24.

The rejection cited Mielenhausen, Col. 8, lines 67 to Column 9, line 16 that describe "LRO's [Legal Research Organizer] Web sites Search Results Window," which is described with respect to a "Step **430:** Input Word Search Data for Each Proposition" (See Col. 7 line 33); Col. 10, lines 59 to 67 that describe "LRO's Paste/View Insta-Cite® List Window and the Paste/View Auto-Cite® List Window," in a Step **520:** Input Citator Services Information Related to Each Authority" (See

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Col. 10, lines 37-8); and Col. 11, lines 9 to 28 that describe "LRO's Shepards® Results Window" also in step 520.

Thus, the rejection selectively extracted the description of how a user utilizes three different windows in a legal research organizer without providing any rationale or reason why one of skill in the art would make such a selection. Moreover, the rejection failed to cite any teaching in this user editing, deleting, cutting pasting, etc. that related to synchronizing anything. In particular, Mielenhausen, Col. 8, line 67 to Col. 9, line 16 stated:

> (g) Cases, statutes, legislative history, articles and other authorities can now be found at numerous web sites on the Internet, including web sites maintained by state and federal appellate courts and governmental agencies. After performing the word search highlighted in the Word Searches Window, via a web site, the user can enter, organize and analyze the results in LRO. Through LRO's Web Sites Search Results Window, the user can view, add, edit and delete citations obtained from the web site. The Search Results Window shows the web site name and address, jurisdictions searched, a list of citations, and other related data entered/edited by the user. The web site address is in hyper-link text (i.e., double-clicking on the data opens the web address indicated). Each citation is accompanied by the status of its review and the date the status was last updated. LRO orders the list of citations alphabetically. Only one citation at a time is highlighted. (Emphasis added)

Entering, organizing and analyzing results of a search fail to suggest anything concerning synchronizing a reference database with other data sources as recited in Claim 7.

Similarly, Mielenhausen, Col. 10, lines 59 to 67 stated:

> (a) Through LRO's Paste/View Insta-Cite® List Window and the Paste/View Auto-Cite® List Window, the user can paste a list of citations, downloaded from the Insta-Cite® and Auto-Cite® citator services, related to the authority highlighted in the Authorities Window. The user can then add one or more of those citations to the Insta-Cite® Search Results Window and Auto-Cite® Search Results Window, along with data showing the status of the user's review of each citation.

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These two cited sections are dealing with different things and provide no indication that the user actions were done to synchronize a reference database with other data sources, as recited in Claim 7. Similarly, the last citation is directed to a user entering and analyzing results.

Appellant notes that while the examiner is permitted to interpret claim limitations broadly, the MPEP puts specific bounds on such an interpretation. Specifically,

CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

> During patent examination, the pending claims must be "given *>their< broadest reasonable interpretation consistent with the specification."

MPEP § 2111 8th Ed. Rev. 2, p 2100-46 (May 2004).

> The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.

MPEP § 2111 8th Ed. Rev. 2, p 2100-47 (May 2004).

> **>Claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art.

MPEP § 2111.01, II., 8th Ed. Rev. 2, p 2100-48 (May 2004).

Thus, Appellant respectfully submits that the interpretation used in the rejection of Claim 7 is neither related to Appellant's claim language nor related to the interpretation that would be used by those of skill in the art. Picking and choosing selectively from a prior art reference, as demonstrated above, cannot be based on a broad interpretation of the claim language. The MPEP, as quoted above with respect to Claim 1, requires that some rationale be provided for such selective dissection of a reference. Not only was such a rationale not provided, but also the cited sections have nothing to do with a reference database in a single data file as recited in these claims.

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In conclusion, Appellant has explained why the combination of Nurse et al. in view of Amro et al. and further in view of Mielenhausen, taken as a whole, does not suggest the subject matter of Claims 7, 21, and 24. Thus, the Examiner's rejection of Claims 7, 21, and 24 as being unpatentable over the combination of Nurse et al, Amro et al. and Mielenhausen should be reversed.

Claim 9 Is Patentable Over The Combination of References

Claim 9 depends from Claim 1 and so distinguishes over the combination of references for at least the same reasons as Claim 1 given above, which are incorporated herein by reference. Thus, the Examiner's rejection of Claim 9 as being unpatentable over the combination of Nurse et al, Amro et al. and Mielenhausen should be reversed.

Claim 11 is Patentable Over The Combination of References

Claim 11 depends from Claim 10 and so distinguishes over the combination of references for at least the same reasons as Claim 10 given above, which are incorporated herein by reference. Thus, the Examiner's rejection of Claim 10 as being unpatentable over the combination of Nurse et al, Amro et al. and Mielenhausen should be reversed.

3. Claims 5 and 19 are patentable over U.S. Patent No. 5,097,418 of Nurse et al. in view of U.S. Patent No. 5,867,678 of Amro et al. and further in view of U.S. Patent No. 6,289,342 of Lawrence.

Claim 5 stands rejected as obvious in view of Nurse and Amro taken together with U.S. Patent No. 6,289,342 B1, hereinafter Lawrence. However, assuming that the combination of the three references is correct and that the interpretation of the three references is correct (Appellant notes that by

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making these assumptions Appellant does not concede that either of these facts is correct), the additional information from the third reference does not correct the deficiencies of the two primary references as noted above with respect to Claim 1 and incorporated herein by reference.

The final rejection stated:

> **"the reference database further comprises one field containing information about a number of citations of a reference in the document' [Sic]** as storing in Tables 2-4, the number of citations, baseline sample, and word matching etc. . . for the reference documents for ranking similarity of documents (col. 15, tables 2-4).

Final Office Action dated 03/23/2005, Page 16.

The cited tables in Lawrence are not describing a database, but rather are:

> Tables 2 and 3 show the results with and without normalization respectively, and Table 4 shows the running time of the various algorithms.

Lawrence, Col. 14, lines 38 to 40.

This is further evidence that Lawrence has not been considered as a whole and demonstrates that only "Number of Citations" was considered without consideration of the context in which the phase was used in Lawrence. Picking and selectively extracting portions of Tables in Lawrence summarizing test results and then arguing that the extracted test results teach anything concerning a reference database is not consistent with the analysis required by the MPEP. The characterization in the rejection is unsupported by any teaching in Lawrence and is simply extracting terms in the claim from a reference without consideration to the teachings as a whole of the three references.

In conclusion, Appellant has explained why the combination of Nurse et al. in view of Amro et al. and further in view of

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Lawrence, taken as a whole, does not suggest the subject matter of Claims 5, and 19. Thus, the Examiner's rejection of Claims 5 and 19 as being unpatentable over the combination of Nurse et al., Amro et al. and Lawrence should be reversed.

CONCLUSION

For the reasons above, all appealed claims, i.e., Claims 1 to 24, are allowable. Appellant respectfully requests the Board of Patent Appeals and Interferences to reverse the Examiner's various rejections under U.S.C. §103 of these claims.

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APPENDIX

1. (Previously Presented) A method of creating a reference database for a computer-readable document comprising:

entering user inputted text data for said computer-readable document in a data file;

determining whether a user inputted a request to input reference data wherein said reference data characterizes a reference data source;

entering user inputted reference data into the reference database following said determining finding said user inputted said request to input reference data; and

storing the reference database, said user inputted text data, and other data of the computer-readable document in said data file wherein said other data includes at least one citation to said user inputted reference data.

2. (Original) The method of claim 1, wherein the computer-readable document further comprises a reference field for retrieving a record stored in the reference database.

3. (Previously Presented) The method of claim 1, wherein the reference database further comprises:

fields for different types of reference data sources; and

fields containing specific information associated with these different types of reference data sources.

4. (Previously Presented) The method of claim 3, wherein the reference database comprises a bibliographic database, and the reference data sources comprise books, journals, conference presentations, web-pages and e-mails.

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5. (Previously Presented) The method of claim 4, wherein the reference database further comprises one field containing information about a number of citations of a reference in the document.

6. (Previously Presented) The method of claim 1, further comprising: displaying a user interactive dialogue window for inputting reference data.

7. (Previously Presented) The method of claim 1, further comprising:

synchronizing the reference database with other data sources.

8. (Previously Presented) The method of Claim 1, wherein said method is stored as computer code in a storage medium.

9. (Previously Presented) The method of Claim 8, wherein said computer code is downloaded into said storage medium.

10. (Previously Presented) An apparatus comprising:

a processor; and

a storage medium coupled to said processor, and including a reference database for a computer-readable document, storing user inputted reference data wherein said reference data characterizes a reference data source, together with said computer-readable document including user inputted text data in a single data file wherein said computer-readable document includes at least one citation to information in said reference database.

11. (Previously Presented) The apparatus of Claim 10, wherein said processor is in a first device, and said storage medium is in a second device.

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12. (Previously Presented) A storage medium having stored thereon in a single data file a computer-readable document comprising a reference database storing user inputted reference data, wherein said reference data characterizes a reference data source, user inputted text data and other data of the computer-readable document wherein said other data includes at least one citation to said user inputted reference data.

13. (Previously Presented) The storage medium of claim 12, wherein the computer-readable document further comprises reference fields.

14. (Previously Presented) The storage medium of claim 12, wherein the reference database contains fields for different types of reference data sources and fields containing specific information associated with these data sources.

15. (Previously Presented) A computer program for creating a reference database for a computer-readable document, the computer program comprising program code adapted for:

entering user inputted text data for said computer-readable document in a data file;

determining whether a user inputted a request to input reference data, wherein said reference data characterizes a reference data source;

entering user inputted reference data into the reference database following said determining finding said user inputted said request to input reference data; and

storing the reference database, said user inputted text data, and other data of the computer-readable document in said data file wherein said other data includes at least one citation to said user inputted reference data.

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16. (Original) The computer program of claim 15, wherein the computer-readable document comprises a reference field for retrieving a record stored in the database.

17. (Original) The computer program of claim 15, wherein the reference database comprises fields for different types of reference data sources, and fields containing specific information associated with these data sources.

18. (Original) The computer program of claim 17, wherein the reference database comprises a bibliographic database and the data sources include books, journals, conference presentations, web-pages and e-mails.

19. (Original) The computer program of claim 18, wherein the reference database comprises one field containing information about the number of citations of a reference in the computer-readable document.

20. (Previously Presented) The computer program of claim 15, further comprising instructions for displaying a user interactive dialogue window on a display screen.

21. (Original) The computer program of claim 20, comprising computer code allowing synchronization of the reference database with other data sources.

22. (Previously Presented) A computer program product for creating a reference database for a computer-readable document, the computer program product comprising program code adapted for:

entering user inputted text data for said computer-readable document in a data file;

determining whether a user inputted a request to input reference data, wherein said reference data characterizes a reference data source;

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entering user inputted reference data into the reference database following said determining finding said user inputted said request to input reference data; and

storing the reference database, said user inputted text data, and other data of the computer-readable document in said data file wherein said other data includes at least one citation to said user inputted reference data.

23. (Original) The computer program product of claim 22, wherein reference fields are included in other data for retrieving the reference data stored in the reference database.

24. (Original) The computer program product of claim 23, further comprising program code allowing synchronization of the reference database with other data sources.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 26, 2005.

Attorney for Applicant(s) — September 26, 2005 Date of Signature

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